Supreme Court, U. S.
FILED
JUN 1 1976
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1975

No. 75-1380

SARAH COVENTRY, INC.,
Petitioner,

v.

T. SARDELLI & SONS, INC.,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

ARGUMENT

POINT I

(a) Respondent's brief admits conflict of the Circuit Courts as to issue in this case.

The Respondent raises for the first time and inaccurately the argument (at page 6) that Petitioner argued cases "having no bearing upon the fact situation here" because in the cited cases ". . . there is no proof of likelihood of confusion other than the marks themselves". It is not a question of whether there were *proofs* of anything other than the marks themselves, but rather whether there were any *issues* other

than a comparison of the marks themselves, and that was the *sole issue* in the present case, just as it was in the pertinent cases accurately cited by the Petitioner.

Clearly, as pointed out at pages 17-18 of the petition, by quotations, the Trademark Trial and Appeal Board, the District Court and by the stipulation of the parties themselves, *the sole issue* in this case was the simple comparison of "whether 'SARDE' is confusingly similar to 'SARAH' " (App. 31a).

Respondent's Brief (page 6) goes on to *admit* in such cases, ". . . some Courts of Appeal have indicated that they can pass on likelihood of confusion as well as the trial Court, because all the evidence, *i.e.* the marks themselves is before the Court".

Thus, *the Respondent's* own *brief admits the conflict* which exists between those circuits where the *appeal courts decide the issue of likelihood of confusion* with the First Circuit Court of Appeals' decision in the present case were the First Circuit Court of Appeals refused to make such an independent decision. This conflict is an important one to which this Court should give direction to all circuits in order to have consistent decisions and fair justice.

(b) Respondent's quotations do not refute the conflict between the present case and the Sixth Circuit [I(c) page 14 Petition] and the Circuit Court for the District of Columbia [I(f) page 15] and the Court of Customs and Patent Appeals [I(g) page 15].

Therefore, even assuming the accuracy of Respondent's citations, the Respondent's brief clearly does not refute the conflict which exists between circuit Courts of appeal which should be resolved by this Court.

(c) Likelihood of confusion of law.

The Respondent is simply in error in arguing (at page 3) that likelihood of confusion is a question of fact. As can be seen from each of the following quotations from the Courts of appeal from those circuits in conflict with the First Circuit Court of Appeals, there can be many *related* or *extrinsic* questions of fact which are reviewed on appeal under the clearly erroneous test of F.R.C.P. Rule 52(a) 28 U.S.C., but the ultimate issue of *likelihood of confusion* is a question of *law* which should be decided by the appeal Court—and in the case at hand, where the only issue is the similarity of the marks when compared, then the *only* determination for the appeal Court to make is a question of law as to the likelihood of confusion (most of the following quotations are from Petitioner's original brief with a preceding or succeeding statement pointing out the above argued difference):

Miss Universe, Inc. v. Patricelli, (1969, CA2) 408 F2d 506, 509

> "To the [4] degree that the determination of 'likelihood of confusion' rests upon a comparison of the marks themselves, the appellate court is in as good a position as the trial judge to decide the issue. J. R. Wood and Sons, Inc. v. Reese Jewelry Corp., 278 F.2d 157, 158, 125 USPQ 367, 368 (2 Cir. 1960); Miles Shoes, Inc. v. R. H. Macy & Co., Inc., 199 F. 2d 602, 95 USPQ 170 (2 Cir. 952). *On the other hand, the district court's findings with respect to the other relevant factors*—e.g., the existence of actual confusion and the alleged infringer's intent—*are subject to the 'clearly erroneous'* standard normally applicable to findings of fact" (emphasis added).

Sears Roebuck & Co. v. Johnson, (3 Cir., 1955) 219 F2d 590, 591

> "[1] In considering whether or not the district court erred in finding that no likelihood of confusion existed, this court is not bound (although defendants contend

otherwise) by Rule 52(a) of the Federal Rules of Civil Procedure.[1] *In disturbing a district court's findings of basic facts, this court is guided by the 'clearly erroneous' provision of Rule 52(a). But Rule 52(a) is not applicable where, as here, the dispute is not as to the basic facts,* but as to what inference (i.e., ultimate fact) should reasonably be derived from the basic facts. This court, by examining the basic facts found by the district court, can determine, as advantageously as the district court can, whether or not an inference of likelihood of confusion is warranted.[2]" (emphasis added)

McCormick & Co. v. B. Manischewitz Co., 6 Cir., 206 F2d 744, 746, 98 USPQ 367, 369

"[2] It also follows that while *extrinsic facts* are significant, *the likelihood of confusion may as readily be perceived by a reviewing court upon visual comparison as by a court of first instance,* unless extrinsic facts compel determination one way or the other." (emphasis added)

Aloe Creme Laboratories, Inc. v. Aloe 99, Inc., (CCPA) (485 F2d 1241)

"[1] While it is true that *the ultimate issue of likelihood of confusion, etc., is 'one of law,' there are many factual questions* other than the descriptiveness of a part of the marks which opposer is entitled to have considered and on which it should be given an opportunity to present evidence . . ." (emphasis added)

(d) Respondent's Citations Not Pertinent.

The Respondent's brief fails to refute the accuracy of the quotations in the petition of the conflicting circuit Court decisions. Except for the Fifth and Eighth circuit decisions cited by the Respondent, the quotations relied upon by the Respondent appear not to be pertinent to the issue now before this Court because the Respondent's quotations are of cases in which *extrinsic* or *related* questions of fact were involved (*i.e.*, actual confusion, secondary meaning, descriptiveness of the trademark, and unfair competition between trade dress of

products) rather than the situation which exists in the present case where the sole issue is a *question of law* of whether there is a likelihood of confusion based on a simple comparison of the trademarks.

(e) Even if Respondent's quotations are pertinent, they further point out a conflict which requires this Court's clarification.

Moreover, even assuming that the Respondent's quotations were pertinent, then they would simply point out that there is even a conflict of decisions within some of the circuits themselves and hence all the more reason the United States Supreme Court should accept the petition in this case and resolve the conflict.

Respectfully submitted,

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